

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES GILBERT HEISINGER, JR.

Appeal 2007-2394
Application 09/545,088¹
Technology Center 2100

Decided: April 28, 2008

Before JEAN R. HOMERE, JAY P. LUCAS, and SCOTT R. BOALICK,
Administrative Patent Judges.

BOALICK, *Administrative Patent Judge.*

¹ Application filed April 7, 2000. The real party in interest is Charles G. Heisinger, Jr, the inventor.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 36-40, 44, and 47-64, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Appellant's invention relates to telephonically selecting, addressing, and distributing messages. In the words of the Appellant:

The present invention relates to a method and system for retrieving information in response to caller input from a telephone keypad and for delivering the information to an address specified by destination address information maintained through an Internet website and stored in a database, which is selected based on caller identification provided electronically with the inbound telephone call, and in a distribution means specified by the caller.

(Spec. 1:22-29.)

Claim 36 is exemplary:

36. A method of addressing an electronic message, comprising the steps of:

providing a first database containing stored telephone numbers and user addresses for each of the stored telephone numbers;

providing a second datable containing
identification codes and product information
corresponding to each of the identification codes;

receiving a telephone call from a user
including one of the identification codes;

identifying the received telephone number
from the telephone call;

retrieving the user address from the first
database by comparing the received telephone
number with the stored telephone numbers;

retrieving the product information
corresponding to the received identification code;

addressing the electronic message according
to the retrieved address; and

sending at least a portion of the retrieved
product information via the electronic message,
wherein the first and second databases are used to
create the electronic message.

The prior art relied upon by the Examiner in rejecting the claims on
appeal is:

Bateman	US 5,884,032	Mar. 16, 1999
Call	US 5,913,210	Jun. 15, 1999

Applicant Admitted Description Prior Art, page 1, line 34 to page 2,
line 5 of the present Specification (APA).

Claims 36-40, 44, and 57-64 stand rejected under 35 U.S.C. § 103(a) as being obvious over Bateman and Call.

Claims 47-56 stand rejected under 35 U.S.C. § 103(a) as being obvious over Bateman, Call, and the APA.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).²

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a).

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a prima facie case of unpatentability. *Id.* at 1472.

² Except as will be noted in this opinion, Appellant has not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

When that burden is met, the burden then shifts to the applicant to rebut. *Id.*; see also *In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the applicant produces rebuttal evidence of adequate weight, the prima facie case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is an appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). "To facilitate review, this analysis should be made explicit." *KSR*, 127 S. Ct. at 1741. However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* The Supreme Court cautioned that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *Id.* at 1742.

ANALYSIS

Appellant contends that the Examiner erred in rejecting claims 36-40, 44, and 47-64. Reviewing the record before us, we agree. In particular, we find that Appellant has shown that the Examiner failed to make a prima facie showing of obviousness with respect to claims 36-40, 44, and 47-64 as key limitations of the claims were not shown to be in the cited prior art.

Therefore, Appellant has shown that the Examiner erred in rejecting claims 36-40, 44, and 57-64 under 35 U.S.C. § 103(a) as being obvious over Bateman and Call and in rejecting claims 47-56 under 35 U.S.C. § 103(a) as being obvious over Bateman, Call, and the APA.

With respect to independent claim 36, we agree with Appellant that neither Bateman nor Call teaches or suggests the limitations of "retrieving the user address from the first database by comparing the received telephone number with the stored telephone numbers," "addressing the electronic message according to the retrieved address," and "sending at least a portion of the retrieved product information via the electronic message, wherein the first and second databases are used to create the electronic message," as claimed. (App. Br. 13-17.)

The Examiner found that the customer's PC 4 disclosed by Bateman (Fig. 1 and col. 5, ll. 3-12) teaches the claimed first database containing stored telephone numbers and user addresses for each of the stored telephone numbers. (Ans. 3, 5.) The Examiner also found that the agent workstation computer 18 disclosed by Bateman (Fig. 1 and col. 6, ll. 48-50) teaches the claimed second database containing identification codes and product information corresponding to each of the identification codes. (Ans. 3-4.)

Next, the Examiner found that the inbound call processing capabilities of the call center disclosed by Bateman (col. 8, l. 10 to col. 9, l. 47) teaches the claimed limitation of retrieving the user address from the first database by comparing the received telephone number with the stored telephone numbers because "as calls from cld's [calling line identification, col. 9, l. 3] come in the database can correlate the associated caller and URL, (see col. 9, lines 21-32 and col. 9, lines 10-12)." (Ans. 4.) The Examiner found that Bateman does not disclose sending at least a portion of the retrieved product information by electronic message, where the first and second databases are used to create the electronic message. (Ans. 4.) However, the Examiner found that "Call discloses a method for sending at least a portion of the retrieved user [sic, product] information via electronic message, and wherein the first and second databases are used to create the electronic message (see Call col. 7, lines 10-30)." (Ans. 4.)

Contrary to the Examiner's findings, however, Bateman does not teach or suggest that the user address is retrieved from the first database (i.e., the customer's PC 4) by comparing the received telephone number with stored telephone numbers. Instead, Bateman teaches that, for inbound call processing of an inbound call to the call center agent's workstation, "[t]he CLID [Calling Line Identification] is transmitted over the telephone line and the CLID box detects this and passes it to the agent's PC." (Col. 9, ll. 4-7.) Then, "[s]creen pop software takes the telephone numbers provided by the CLID box and looks up the corresponding customer records in a database." (Col. 9, ll. 10-12.) As an alternative, a third party server can deliver the CLID and/or customer relevant data to the agent's workstation. (Col. 9, ll. 13-18.) Thus, in Bateman, the first database (customer's PC 4) is not used

to retrieve a user address by comparing the received telephone number with stored telephone numbers.

Call was cited for the teaching of an electronic message, and we find nothing in Call to remedy the above noted deficiencies of Bateman. Thus, neither Bateman nor Call, alone or in combination, teaches or suggests the claimed limitation of "retrieving the user address from the first database by comparing the received telephone number with the stored telephone numbers."

Because neither Bateman nor Call teaches or suggests retrieving the user address from the first database, they also do not teach or suggest the claimed limitation of "addressing the electronic message according to the retrieved address."

In addition, the portion of Call cited by the Examiner (col. 7, ll. 10-30) discloses an SMTP forwarding agent to forward a received email to another email address according to the product code. However, that portion of Call does not teach or suggest "sending at least a portion of the retrieved product information via the electronic message, wherein the first and second databases are used to create the electronic message," as claimed. Nor do we find such a teaching or suggestion anywhere else in Call or in Bateman.

Therefore, we conclude that Appellant has shown that the Examiner erred in rejecting claim 36 under 35 U.S.C. § 103(a). Claims 37-40 and 44 depend from claim 36, and we find that the Examiner erred in rejecting these claims for the same reasons as discussed with respect to claim 36.

Independent claim 57 recites, similarly to independent claim 36, "retrieving the user information from the first database by comparing the

received telephone number with the stored telephone number" and "wherein the first and second databases are used to create the electronic message." As discussed with respect to independent claim 36, we have found these features to be lacking from Bateman and Call.

Furthermore, independent claim 57 recites "purchasing the product with an electronic message based upon the user information retrieved from the first database and the product information retrieved from the second database." We do not find this feature to be taught or suggested by Call, as asserted by the Examiner (Office Action mailed Aug. 2, 2004 at 7).

The portion of Call relied upon by the Examiner for support states that "Internet Service Providers . . . may provide shared computer services which interoperates [sic] with a reseller's inventory control system to provide customers with the information they desire before and after making purchases." (Call col. 12, ll. 36-40.) We do not find this, or any other portion of the product code translator of Call, to be sufficiently detailed so as to teach or suggest purchasing the product with an electronic message based upon the user information retrieved from the first database and the product information retrieved from the second database, as claimed. Bateman does not remedy this deficiency of Call.

Therefore, we conclude that Appellant has shown that the Examiner erred in rejecting claim 57 under 35 U.S.C. § 103(a). Claims 58-64 depend from claim 57, and we find that the Examiner erred in rejecting these claims for the same reasons as discussed with respect to claim 57.

Independent claim 47 recites, similarly to independent claim 36, that "the processor retrieves the user information from the first database by comparing the received telephone number with the stored telephone

numbers" and "wherein the first and second databases are used to create the electronic message." As discussed with respect to independent claim 36, we have found these features to be lacking from Bateman and Call. The APA was cited for the teaching of an ANI (Automatic Number Identification) for identifying the received telephone number from the telephone call (Office Action mailed Aug. 2, 2004 at 8), and we find nothing in the APA to remedy the above noted deficiencies of Bateman and Call.

Therefore, we conclude that Appellant has shown that the Examiner erred in rejecting claim 47 under 35 U.S.C. § 103(a). Claims 48-55 depend from claim 47, and we find that the Examiner erred in rejecting these claims for the same reasons as discussed with respect to claim 47.

Independent claim 56 recites, similarly to independent claims 36 and 47, "retrieving the user information from the first database by comparing the received telephone number with the stored telephone numbers" and "wherein the first and second databases are used to create the electronic message." As discussed with respect to independent claims 36 and 47, we have found these features to be lacking from Bateman, Call, and the APA.

Therefore, we conclude that Appellant has shown that the Examiner erred in rejecting claim 56 under 35 U.S.C. § 103(a).

CONCLUSION OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 36-40, 44, and 47-64.

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DECISION

We reverse the Examiner's decision rejecting claims 36-40, 44,
and 47-64.

REVERSED

gvw

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